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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/309,367	05/11/99	WILSON	K 241/036

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PM82/1214

EXAMINER

VANAMAN, F

ART UNIT	PAPER NUMBER
3611	7

DATE MAILED:

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>09/309,367</b>	Applicant(s) <b>Wilson</b>
	Examiner <b>Frank Vanaman</b>	Group Art Unit <b>3611</b>

Responsive to communication(s) filed on Nov 12, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-36 is/are pending in the application.

Of the above, claim(s) 1-17 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 18-36 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**Election/Restriction**

1. Applicant's election without traverse of Invention II in Paper No. 6 is acknowledged.
2. Claims 1-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 6.
3. An office action on the merits of claims 18-36 follows.

**Specification**

4. The disclosure is objected to because of the following informalities: on page 4, line 14, "or .0625" should be --of .0625--.

Appropriate correction is required.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because it fails to provide an adequate written description. On page 6, lines 27-29 and page 19, lines 13-16 the specification refers to a

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process of casting a metal board around various fillers, to include "compressed air", the filler being provided in the shape of a desired longitudinally extending cavity. The disclosure on page 6 refers to both compressed air and a bladder, while it is clear that a bladder can be formed to a particular shape, it is not clear that "compressed air", lacking any further details, can be so formed or shaped so as to provide a filler around which a metal board may be cast.

#### **Claim Rejections - 35 USC § 112**

6. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 22 refers to a casting of a metal board around a number of fillers, including 'compressed air'. As set forth above, it is not clear how compressed air can be formed nor how it can serve as a filler around which a metal board may be cast.

#### **Double Patenting**

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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8. Claims 18, 20, 23-28, 31 and 33 are provisionally rejected under the judicially created doctrine of double patenting over the claims of copending Application No. 09/206,720. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: A method of making a board having one or more hollow sections including extruding the board from an aluminum material of either 6000 series or other type ('720 specification, page 4), bending to a predetermined angle and/or shaping the board, followed by heat treating the board to harden it. Note in particular claims 10, 25, 26, 27 of the copending application, and pages 3, 4 and 5 of the specification.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

#### **Claim Rejections - 35 USC § 102**

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 18 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Stevenson (US 4,337,963, cited by applicant). Stevenson teaches a sports board having a top, bottom sides, and hollow sections, of a substantially short elongation as broadly claimed, which may be cast from aluminum (col. 1, lines 38-41) and wherein the board profile (note figure 4) is shaped at

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predetermined angles at both front and back, the shaping being accomplished by a post-forming process (col. 1, lines 30-33).

11. Claims 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Evancho et al. (US 4,082,578). Evancho et al. teach a process for making plate-shaped aluminum vehicle elements, to include a providing step (extrusion, col. 9, lines 66 - col. 10, line 4), a heat annealing step (col. 10, lines 8-13, 20-25, and 40-42) to a condition less than T-5 hardness (in this case T-4); a working and shaping step (col. 11, lines 60-63) and a hardening step to at least a T-5 condition (in this case T-6; col. 12, lines 9-26).

### **Claim Rejections - 35 USC § 103**

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 18, 20, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellett (US 3,561,783) in view of Mayr (US 5,249,819). Ellett teaches a ski bike having a ski (30) which may optionally be extruded from aluminum (col. 2, lines 1-2) with top, bottom, left and right sides, in addition to front and rear portions which are shaped at predetermined angles. The reference of Ellett fails to teach a longitudinally elongated hollow section in the ski.

Mayr teaches a sport ski which may be formed through an extrusion process (col. 3, lines 4-9) having a plurality of hollow longitudinally elongated sections (note figures 2a, 2b, 2c). It would have been obvious to one of ordinary skill in the art at the time of the invention to make the extruded ski of Ellett with at least a single hollow section as taught by Mayr for the purpose of reducing weight and increasing resistance to torsion.

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The reference of Ellett as modified by Mayr fails to explicitly teach a method of forming the ski, however such a ski would be formable by the method steps as claimed.

14. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stevenson in view of Evancho et al. (US 4,082,578). The reference of Stevenson fails to teach an annealing step prior to a shaping step. Evancho et al. teach a series of manufacturing steps for aluminum items including an annealing step (col. 10, lines 8-13, 20-25, and 40-42) which is executed prior to a working and shaping step (col. 11, lines 60-63). It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the annealing step as taught by Evancho et al. for the purpose of insuring the shaping process does not result in a brittle failure.

15. Claims 19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellett as modified by Mayr as applied to claim 18 above, and further in view of Evancho et al. (US 4,082,578). See below.

Claims 25-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellett in view of Mayr and Evancho et al.

The references of Ellett and Mayr are discussed in detail above, and fail to teach further steps to include an annealing step to a particular hardness prior to shaping the board and a hardening step after shaping the board.

Evancho et al. teach a process for making plate-shaped aluminum vehicle elements, to include an extrusion step (col. 9, lines 66 - col. 10, line 4), followed by a heat annealing step (col. 10, lines 8-13, 20-25, and 40-42) to a condition less than T-5 hardness (in this case T-4); a working and shaping step (col. 11, lines 60-63) and a hardening step to at least a T-5 condition (in this case T-6; col. 12, lines 9-26). It would have been obvious to one of ordinary skill in the art at the time of the invention to produce the ski element taught by Ellett as modified by Mayr by the steps taught by Evancho et al., the pre-shaping annealing for the purpose of insuring the shaping

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process does not result in a brittle failure, and the further hardening for the purpose of insuring high strength in the final product.

As regards claims 26, 27, 30 and 31, while Evancho et al. fail to explicitly teach that the extrusion, annealing and hardening steps may be used with a 6000 series alloy, for example 6005 or 6061, it would have been obvious to one of ordinary skill in the art at the time of the invention to adjust the particular annealing and hardening times and temperatures to accommodate these alloys in order to allow the same advantages (e.g., insuring the shaping process does not result in a brittle failure; and insuring high strength in the final product) to users of 6005 and 6061 alloys. As regards claim 32, it would not be considered an unobvious modification of the steps taught by Evancho et al. to anneal to a T-0 condition, for example should a great deal of shaping or other working processes be envisioned prior to the final hardening.

16. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stevenson. The reference of Stevenson is discussed above and fails to explicitly teach the casting process as casting the board element around a filler. While Stevenson fails to explicitly teach the mold into which the board elements are cast, in view of the plurality of recesses formed in the board (figures 2, 3, 5) it would be necessary to cast the board around a filler, as broadly claimed, in this case the mold, to form the recesses, and as such it would have been obvious to one of ordinary skill in the art at the time of the invention to cast the board around a filler, such as the mold, for the purpose of forming the internal void spaces and support webs of Stevenson.

17. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stevenson in view of Le Masson et al. (US 5,248,160). The reference of Stevenson fails to teach the inner void spaces as containing a filler. Le Masson et al. teach a ski structure having a plurality of filler elements (core 22 - which may be a foam, wood or aluminum material, filler 31- which may be an elastic foam material). It would have been obvious to one of ordinary skill in the art at the time of

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the invention to fill the void spaces taught in the cast board of Stevenson with a filler material such as a foam or wood for the purpose of reducing or damping vibrations in the board, and improving handling of the board.

### **Conclusion**

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cox (US 2,926,364), Vogel (US 3,762,734), Mayr et al. (US 5,299,822), Dickson, Jr. (US 5,507,888), Ihm (US 5,509,510 and 5,620,042) teach various structures and manufacturing techniques of pertinence.
19. Applicant is reminded that claims 1-17 have not been treated in this office action as they are withdrawn from consideration at this time.
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Vanaman whose telephone number is (703) 308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Assistant Commissioner for Patents  
Washington, DC 20231

or faxed to :

(703) 305-3597 or 305-7687 (for formal communications intended for entry; informal or draft communications may be faxed to the same number but should be clearly labeled "UNOFFICIAL" or "DRAFT")

**FRANK B. VANAMAN**  
Patent Examiner  
Art Unit 3611

December 10, 1999



12/10/99